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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,005	09/25/2003	Tatsuya Igarashi	Q77667	6240
23373	7590	03/21/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			GARRETT, DAWN L	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/670,005

**Applicant(s)**

IGARASHI ET AL.

**Examiner**

Dawn Garrett

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-12 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9-25-03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Compounds according to formula (I) (shown in claim 1).

Applicant should indicate if  $R^{11}$  and  $R^{12}$  are hydrogen or a substituent

Applicant should indicate for each of  $Y^{11}$ ,  $Y^{12}$ , and  $Y^{13}$  if the variable is substituted carbon, unsubstituted carbon, substituted nitrogen, unsubstituted nitrogen, oxygen atom or sulfur atom.

Applicant should indicate for  $M^{11}$  a transition metal.

Applicant should indicate a single ligand for  $L^{11}$ .

Applicant should indicate a single counter ion for  $X^{11}$ .

Applicant should indicate a numerical value for each of  $n^{11}$ ,  $n^{12}$ , and  $n^{13}$ .

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

3. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

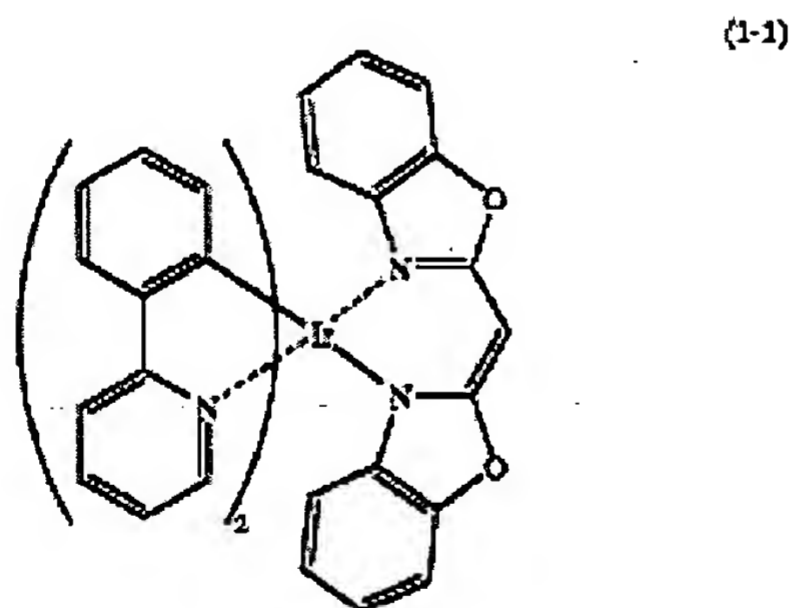
4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. During a telephone conversation with Raul Tamayo on December 10, 2004 a provisional election was made with traverse to prosecute compounds according to formula (1) wherein  $R^{11}$  is substituted,  $R^{12}$  is substituted,  $Y^{11}$ ,  $Y^{12}$  and  $Y^{13}$  are each substituted carbon, M is iridium, L is 2-phenyl pyrrole, there is no counter ion (X),  $n^{11}$  is 1,  $n^{12}$  is 2, and  $n^{13}$  is 0. The following compound (from the specification page 23) was indicated as an ultimate species of the elected species:



The examiner has found the iridium-containing species elected by applicant (compounds according to formula (1) wherein  $R^{11}$  is substituted,  $R^{12}$  is substituted,  $Y^{11}$ ,  $Y^{12}$  and  $Y^{13}$  are each substituted carbon, M is iridium, L is 2-phenyl pyrrole, there is no counter ion (X),  $n^{11}$  is 1,  $n^{12}$  is 2, and  $n^{13}$  is 0) to be allowable subject matter as part of a light emitting layer in an organic

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electroluminescent device. Accordingly, the examiner has selected the following next species for consideration: Compounds according to formula (1) wherein  $R^{11}$  is substituted,  $R^{12}$  is substituted,  $Y^{11}$ ,  $Y^{12}$  and  $Y^{13}$  are each substituted carbon, M is cobalt, L is not present, there is no counter ion (X),  $n^{11}$  is 2,  $n^{12}$  is 0, and  $n^{13}$  is 0. Claims 4-12 and 17-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kishimoto et al. (JP 2000-277262 A). Kishimoto et al. disclose electroluminescent devices comprising a pair of electrodes and a luminescent layer comprising a porphyrin-type compound (see abstract). Kishimoto et al. disclose a cobalt metal containing porphyrin compound, which reads upon the present species under consideration (see par. 30, 32, and formula [1] in columns 6 and 7 of the Japanese patent). It is noted that instant formula (I) does not exclude a porphyrinic

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compound as R<sup>11</sup> and R<sup>12</sup> may generally be a substituent. Kishimoto et al. is deemed to meet the claim limitations.

10. Claims 1-3 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishiko et al. (JP 02-213088 A). Ishiko et al. disclose electroluminescent devices comprising a pair of electrodes and an organic layer comprising a porphyrin-type compound (see abstract). Ishiko et al. disclose cobalt metal containing porphyrin compounds, which read upon the present species under consideration (see Table 2, page 456 of the Japanese patent). The layer containing the porphyrin compound is considered to be light emitting. It is noted that instant formula (I) does not exclude a porphyrinic compound as R<sup>11</sup> and R<sup>12</sup> may generally be a substituent. Ishiko et al. is deemed to meet the claim limitations.

### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 9, 11, 13, 15, and 17-19 of copending Application No. 10/738,307. Although the conflicting claims are not identical, they are not patentably distinct from each other because, the host compound metal complex for a light

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emitting layer described in the co-pending application overlaps with the compounds claimed in the present application (see for example formula (II) in claims 6 and 13).


This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dawn Garrett whose telephone number is (571)272-1523. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Dawn Garrett  
Primary Examiner  
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